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Claims 1-39 are currently pending in this case. Applicant's election of Group II, Claims 11, 13, 15-26, 30 and 35 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)). Claims 1-11, 14, 27-29, 31-34 and 36-39 remain withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention. Election was made without traverse in Paper No. 5.

All rejections of the claims made under 35 U.S.C. § 112 have been dropped by the examiner in light of applicant's arguments with the following exception:

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make the claimed invention. Claim 23 claims polypeptide analogs of metalloproteinase inhibitor (MI). This term is so broad as to include virtually any type of modification known, including insertions, deletions, mutations, and chemical modifications. No

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guidance is provided as to what portions of the disclosed protein can be modified without changing the activity of the protein nor of what types of modifications are likely to produce an active protein. Therefore, undue experimentation would be required of one skilled in the art to make any of the MI protein disclosed.

Claim 23 is again rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The rejections of Claims 15-22 and 35 under 35 U.S.C. § 103 have been dropped by the examiner in light of applicant's limitation of these claims to DNA sequences encoding human MI and applicant's argument that the "Note added in Proof" of Murray et al. would have led one of ordinary skill in the art to believe that the gene encoding the human homolog of the protein taught by Murray had already been cloned.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention

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were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 12, 13, 23-26 and 30 are again rejected under 35 U.S.C. § 103 as being unpatentable over Murray et al. in view of Kimmel for the reasons made of record in the previous office action as these claims are not limited to the expression of human MI and the combined disclosures of Murray et al. and Kimmel make obvious the cloning and expression of the gene for the bovine MI protein disclosed by Murray et al. It is suggested by the examiner that these claims also be limited to DNA sequences encoding human MI in a similar fashion to Claim 15-22.

Claims 15-22 and 35 are allowable over the prior art of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty whose telephone number is (703) 308-4000.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



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SUPERVISORY PATENT EXAMINER
GROUP 180